

Received Event (Event Succeeded)

Date: 11/25/98 Time: 8:24 PM
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Fax Number:
Company: NOV 25 '98 20:37 FR 00-IBM YORKTOWN Subject: 914 945 4073 TO 917033053600 P.22/25
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selected from the group consisting of a rare earth element and a Group III B element, the composition having a superconductive/resistive transition defining a superconductive/resistive-transition temperature range between an upper limit defined by a transition-onset temperature T_c and a lower limit defined by an effectively-zero-bulk-resistivity intercept temperature $T_{p=0}$, the transition-onset temperature T_c being greater than 26°K;

(b) maintaining the superconductor element at a temperature below the effectively-zero-bulk-resistivity intercept temperature $T_{p=0}$ of the superconductive composition; and

(c) causing an electric current to flow in the superconductor element.

REMARKS

Reconsideration is respectfully requested in view of and changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment. In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the

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Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application.

In paragraphs 6-7 on pages 12 -16 of the referenced office action Claims 86-87, 96-108, 115, 118, 120, 122, 123, 129-135 and 137-142 have been rejected under 35 USC 112. All changes suggested by the examiner have been made except for those directed to the terms "layer-like", "perovskite-like", "rare-earth-like", and "layer-type". These terms occur in claims 86-87, 96-108, 112, 113, 117, 118, 122, and 123. Added claims 143 to 163 have the same wording as these claims and include the changes suggested by the examiner to overcome the rejection based on these terms. As stated by applicants in previous responses these are terms of art and well understood by persons of skill in the art.

In paragraph 5 of the referenced office action claims 129-131, 134, 135, 139-142 added by applicants in their response dated April 27, 1998 have been rejected under 35 USC 112 as not enabled. Applicants respectfully disagree. The examiner has given no specific reason why these claims are not enabled.

The examiner has rejected all pending claims, except for claim 136 which is allowable, under 35 USC 102 as anticipated by the Asahi Shinbum article. In the prior response applicants have proven that the conception of applicants' invention was in this country prior to the date of the Asahi Shinbum article and that they were diligent from that time until the actual reduction to practice in this country. Thus applicants have effectively sworn behind the date of the Asahi Shinbum article. The examiner has ignored this stating at page 19 of the office action in paragraph d. ii "Nevertheless, the actual reduction in this country is deemed to have occurred on December 3, 1986, which is after the publication date for the reference." This comment is inconsistent with the law. The examiner is being arbitrary and capacious in not responding to applicants'

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arguments. This is clearly erroneous. Applicants have sworn behind the date of the Asahi Shinbum article and have thus over come the rejection of the claims as anticipated by the Asahi Shinbum article and withdrawal of this rejection is respectfully requested. The examiner is placing applicants in a position of having to guess why in the apparent view of the examiner they have not effectively sworn behind the date of the Asahi Shinbum article. Thus applicants can not properly appeal this rejection since the examiner has not stated a coherent rejection. In view thereof applicant respectfully request that the final rejection be withdrawn so that applicants can be informed of the reason why the examiner apparently believes that applicants have not effectively sworn behind the date of the Asahi Shinbum article by the combination of affidavits under 37 CFR 1.132 which prove that the conception of applicants' invention was in this country prior to the date of the Asahi Shinbum article and that they were diligent from that time until the actual reduction to practice in this country.

Please charge any fee necessary to enter this paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal.

In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

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Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Respectfully submitted,

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